

REMARKS

Claims 1, 2, 4, 5, 8, 12, 21-28 and 30-35 are pending.

Claims 3, 6, 7, 9-11, 13-20 and 29 have been canceled.

Claims 1, 22, 25 and 34 have been amended to recite the subject matter of canceled claims 20 and 29.

Claims 21 and 30 have been amended so as not to depend from a canceled claim.

Claims 22 and 34 have been amended also for clarity.

No new matter has been added by way of the above-amendment.

The following sections correspond with the sections of the outstanding Office Action.

Section 3: Claim Objections and

Section 4: Issues under 35 U.S.C. § 112, Second Paragraph

Claims 22 and 34 are objected to for containing certain informalities. Also, claim 34 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants respectfully traverse the objection and rejection.

The Examiner objects to the way the term "polyether" is used in claims 22 and 34. The Examiner finds claims 22 and 34 are unclear for not clearly setting forth whether each recitation of the term "polyether" relates to a previous recitation of the term "polyether" (i.e., is a further description of a previous recitation of the term "polyether") or is intended to denote a second "polyether". In response, Applicants have amended claims 22 and 34 to clearly recite "a polyether" in the first instance and thereafter to recite "the polyether."

Accordingly, withdrawal of the rejection and objection is respectfully requested.

Sections 5-6: Issues under 35 U.S.C. § 112, First Paragraph (Enablement)

Claims 25-26, 28-33 and 34-35 are rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse the rejection.

The Examiner has taken the position that the specification provides sufficient enablement for the skilled artisan to make and/or use the present invention when the curing agent is "*a silane having at least three (3) silicon atom-bonded hydrolyzable groups per molecule or a partial hydrolytic condensate thereof,*" but the Examiner does not find that the present specification provides sufficient enablement for the skilled artisan to make and/or use the present invention for any curing agents having a hydrolyzable group. On this matter, the Examiner provides no reasoning as to why the present invention, as broadly claimed, is not enabled.

Applicants note that the Examiner has not provided any rational and/or evidence in support of his position that the use of any curing agent is not enabled.

The Examiner's attention is directed to MPEP 2164.01(a) which is now reproduced for the Examiner's convenience.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and

(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. *The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.* 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. (Emphasis added).

In view of the fact that the Examiner has provided **no** arguments and has **not** pointed to a single fact in support of his determination that there would be undue experimentation for the skilled artisan to use any curing agent having a hydrolyzable group for curing the organopolysiloxane (A) as presently claimed, Applicants are not able to provide any counterarguments. The Examiner has simply given a conclusion with no support for that conclusion.

This is the main reason why the burden is initially on the Examiner to set forth a *prima facie* case of lack of enablement. Applicants cannot argue with a bare conclusion.

It is Applicants' position now, as it was at the instant filing date, that a full consideration of the *Wands* factors would lead to a conclusion that the claimed invention meets the requirements of 35 USC 112, first paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

Should the Examiner further elaborates as to why the presently claimed invention is not enabled and should the Examiner maintain this rejection, Applicants respectfully request that the Examiner issues a non-final Office Action which will provide Applicants with at least one opportunity for forwarding arguments and/or evidence in direct response.

Section 7: Issues under 35 U.S.C. § 112, First Paragraph (Written Description)

Claims 1-2, 4-5, 8, 12 and 20-35 are rejected under 35 U.S.C. § 112, first paragraph for lacking written descriptions. Applicants respectfully traverse the rejection.

Specifically, the Examiner objects to the amendment to the claims wherein Applicants clarified that the mol% in the curable organopolysiloxane (A) is based on the "whole of component (A)." The Examiner finds that this is "new matter" to the disclosure.

In response, the Examiner's attention is respectfully directed to the specification where the basis for these mol% ranges can be found. At page 3, lines 11-22, the mol% values are said to be based on the "units of which the backbone is constructed." At page 5, lines 15-16 and again at page 9, lines 27-28 and again at page 12, lines 10-11 in the specification, the mol% is taught to be "based on the entire base polymer."

Accordingly, the claims do not contain new matter and withdrawal of the rejection is respectfully requested.

Sections 8-9: Issues under 35 U.S.C. § 103

The following rejections are pending:

- A. Claims 1-2, 4-5, 8, 12 and 20-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Torto (WO 00/61074)¹; and
- B. Claims 25-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nitzsche (US 3,070,566) in view of Bryan (US 4,657,959) or Chikuni.

Applicants respectfully traverse the rejections.

Upon review of the cited references, Applicants have further amended the independent claims (claims 1, 22, 25 and 34) to clarify that the polyether (C) has an alkenyl group bonded thereto.

With respect to Torto et al., Applicants note that this patent describes the use of "polydiorganosiloxanes having siloxyl units carrying ethylene oxide chain links and/or propylene oxide chain links," (see column 6, lines 3-4). However, this is not the same structure as is now described as polyether (C), since both ends of polyether (C) must have an alkenyl group must be connected directly or indirectly thereto.

With respect to Nitzsche, Bryan and Chikuni, Applicants cannot find anywhere in the disclosure of these references where there is taught or suggested a polyether as defined in the instant claims which requires at least one of C₂H₄O and C₃H₆O groups and both ends of which have an alkenyl group connected directly or indirectly thereto.

Accordingly, significant patentable distinctions exist between the present invention and the cited references.

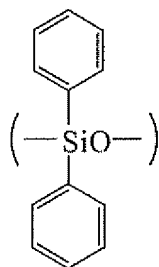
Applicants further believe that the arguments made in the August 8, 2006 Amendment are equally valid now, and as such, Applicants now repeat these arguments.

Previous Arguments

Torto:

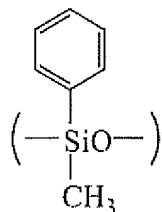
Torto fails to teach or suggest a contact angle of up to 55° as presently claimed. The contact angle of up to 55° is unexpectedly low as compared with a contact angle of 61.1° disclosed in Torto. This shows that Torto fails to disclose or teach the organopolysiloxane has 10 to 50 mol% of diphenylsiloxane unit or 20 to 50 mol% of methylphenylsiloxane unit as a whole of component (A).

The feature of the present invention that 10 to 50 mol% of



the diphenylsiloxane units as a whole of component (A) can impart the criticality on the effect of improving stability sufficient to prevent separation of polyether over time from a cured product having satisfactory hydrophilic property is not expected from Torto.

In this case, the lower limit 10 mol% of the diphenylsiloxane units corresponds to the lower limit 20 mol% of the



methylphenylsiloxane units . Therefore, the criticality

of 20 to 50 mol% of the methylphenylsiloxane units are not expected from Torto either.

¹ The Examiner is relying on the English equivalent of Torto which is US 6,762,242.

With respect to the contact angle of up to 55° , the Examiner relies on the fact that Torto teaches a broad range of less than 80° , see column 14, line 63. However, Torto only shows the skilled artisan how to reduce the contact angle to 61.1° in the Examples (see the table on column 14). Preparing a composition having a contact angle of less than 61.1 degrees appears to be just a wish list for Torto. It is the equivalent to an organic synthetic chemist shooting for a goal of 100% yield. Although, it is theoretically possible to prepare a composition having a contact angle of less than 61.1 degrees, Torto provides no guidance as to how this should be accomplished. References relied upon to support a rejection under 35 USC 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Brown*, 141 USPQ 245, 249 (1964). An invention is not "possessed" absent some known or obvious way to make it. *In re Hoeksema*, 158 USPQ 596, 601 (1968). Accordingly, Torto does not make the present invention obvious, since the assertion of a goal (preparing a composition having a contact angle of less than 61.1 degrees) with nothing more cannot block patentability for one who achieves that goal.

Accordingly, withdrawal of the rejection based on Torto is respectfully requested.

Nitzsche, Bryan and Chikuni:

With respect to Nitzsche, the Examiner asserts that the amount of the phenyl group in Nitzsche's diorganopolysiloxane can be exemplified in Examples, such as Examples 4 and 5 where the amount of phenylmethylsiloxane units can be 24.5 mol% or 45 mol%, and it is obvious to add Bryan's polyether in Nitzsche's composition in order to decrease the water angle of the composition.

However, the silicone rubber stock of Nitzsche is **a room temperature vulcanizing silicone rubber composition of condensation reaction curing type** in which a hydroxy group-containing diorganopolysiloxane is used as a base polymer and is cured with a hydrolyzable silane compound such as an alkylorthosilicate as a crosslinking agent **through**

hydrolytic condensation reaction or with an organohydrogenpolysiloxane as a crosslinking agent **through dehydrogenation condensation reaction**.

Accordingly, firstly, Nitzsche does not disclose a hydrosilylation or addition reaction curable polyorganosiloxane composition of claims 25 and 34 at all.

Moreover, Nitzsche necessarily uses two base polymers of a hydroxy group-containing diorganopolysiloxane and a triorganosilyl terminated diorganopolysiloxane in combination in order to obtain a low modulus cured product.

In Example 4 of Nitzsche, equal parts of the mixture from containers A and B are used. In this case, 100 parts by weight of dimethylpolysiloxane containing 24.5 mol% of phenylmethylsiloxane unit is contained in the total amount (145 parts by weight) of container A. Therefore, the dimethylpolysiloxane is contained in an amount of 69% by weight in container A. On the other hand, 100 parts by weight of triphenylsilyl end-blocked dimethylpolysiloxane containing 5 mol% of methylvinylsiloxane unit is contained in the total amount (202.5 parts by weight) of container B. Therefore, the dimethylpolysiloxane is contained in an amount of 49% by weight in container B.

Accordingly, the base polymer obtained by mixing containers A and B of Nitzsche in equal amounts **only contains 14.3 mol% of phenylmethylsiloxane unit in all the diorganosiloxane units**, which is outside the inventive range.

With respect to Example 5 of Nitzsche, this is a theoretical example and is not an actual example which has been actually carried out to confirm the effect of the present invention but **is only the hypothetical example which had not been actually carried out**. Furthermore, in the composition of Example 5, the curing catalyst is not specified. Therefore, the skilled artisan would not be motivated to combine Example 5 in which the composition is not definitely specified with the compositions of the other references.

In any event, Nitzsche fails to disclose and suggest the inventive compositions of not only hydrosilylation reaction type but also condensation reaction type which contain 10 to 50 mol% of diphenylsiloxane units or 20 to 50 mol% of methylphenylsiloxane units, especially 10 to 50 mol% of diphenylsiloxane units, and the effect of the present invention. Accordingly, Nitzsche fail to teach all of the elements of the instant claims.

Furthermore, the advantageous features of the presently claimed invention as set forth in the present specification would not be expected from Nitzsche.

Lastly, Bryan '959 and Chikuni '414 fail to cure the deficiencies of Nitzsche as described above.

Accordingly, withdrawal of the rejections is respectfully requested.

Improper Finality of the November 2, 2006 Office Action

Applicants note that the Examiner has included a rejection under 35 U.S.C. § 112, first paragraph in section "6" which theoretically could have been included in the previous Office Action dated May 17, 2006 over claim 1 in the February 28, 2006 Amendment. Accordingly, this new rejection was not necessitated by amendment, and it is improper for the Examiner to make the outstanding Office Action final.

To remedy this matter, 1) Applicants respectfully request entry and consideration of this Amendment; and if this Amendment does not result in a Notice of Allowability than 2) the Examiner is requested to prepare a full Office Action (and not just an Advisory Action).

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. Reg.

Application No. 10/724,221
Amendment dated February 2, 2007
After Final Office Action of November 2, 2006


Docket No.: 0171-1044P

No. 43.575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: February 2, 2007

Respectfully submitted,

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